

### **REMARKS**

As an initial matter, Applicants wish to thank the Examiner for the finding of allowable subject matter in the most recent Office Action mailed January 2, 2008 ("*Office Action*").

The *Office Action* considered claims 1, 40-47, 50-65, and 68-90 of which claims 1, 40, 64, 77, and 90 are independent. In addition to the above-noted allowable subject matter, the *Office Action* rejected claim 65 under 35 U.S.C. § 112, ¶ 1 as not being described in the specification at the time of filing. Along these lines, Applicants have amended the term "tool" to "workpiece," which was originally intended term, and is consistent with the general specification and claims in which determinations are made based on "the shaping energy for shaping the *workpiece*." Applicants respectfully submit that this amendment addresses the concern pointed out in the *Office Action*, and, therefore, that the rejection in this regard is now moot.

Similarly, the *Office Action* also rejected claims 47, 50-63, and 68-69 under 35 U.S.C. § 112, ¶ 2 for failing to particularly point out and distinctly claim the subject matter regarded as the invention. In this regard, the *Office Action* asserts that claim 47 is merely redundant with claim 40. As for previously presented claim 47, applicant respectfully disagrees with this assertion. Nevertheless, Applicants have amended claim 47 using the wording of ¶ 23 of Applicants' Application Publication (20060169017) in order to clarify this feature. Applicants further submit that the subject matter of amended claim 47 narrows the subject matter of claim 40. Specifically, claim 40 leaves open the possibility that the first and second tools are both moving at the same time, while claim 47 narrows this feature so that the relative motion so that one tool is stationary with respect to an external reference. Accordingly, Applicants respectfully submit that the § 112 rejection of record for claim 47 is now moot.

As for claims 50-63 and 68-69, Applicants agree that these inadvertently depend from subject matter that was cancelled (due to incorporation into the underlying independent claims for allowability). Inasmuch as Applicants have amended the dependency herewith, Applicants respectfully submit that the remaining § 112 rejections of record are now moot. As no further rejection remains for claims 50-63, Applicants respectfully submit that each of these claims represent additional bases of patentability over the art of record.

As for claims 1, 40-42, 47, and 87, the *Office Action* rejected these claims under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,105,647 to Maher ("*Maher*"), and similarly under 35 U.S.C. 102(b) as being anticipated by German Patent No. DE 2746161 to Guenter ("*Guenter*"). The *Office Action* also rejected claims 43-46 under 35 U.S.C. § 103(a) as being unpatentable over *Maher*, and similarly rejected claims 43-46 under 35 U.S.C. § 103(a) as being unpatentable over *Guenter*.

With this paper, Applicants herewith cancel claim 1, and amend claims 40, 50, 52, 68, and 68.

As for claim 40, Applicants have reintroduced the phrase "during the relative motion of the tools toward one another," which was previously removed to satisfy the § 112 rejection in the Office Action dated July 24, 2007 (due to the originally filed claim term "preferably"). While Applicants admit that the recent amendment in Applicants' "Amendment B" can be construed as rendering claim 40 broader than originally considered in the July 24<sup>th</sup> Office Action, Applicants respectfully submit that the present amendment to claim 40 now comprises each of the limitations of claims 40, and 48-49 prior to the July 24<sup>th</sup> Office Action. As this prior combination of claims was deemed allowable over *Maher* in the July 24<sup>th</sup> Office Action, Applicants respectfully submit that current amendments to claim 40 return this claim to its

allowable form (over *Maier*). Furthermore, Applicants respectfully submit that *Guenther* fails to teach, disclose, or otherwise suggest each of the limitations of amended independent claim 40 in present form, including "detecting a triggering time when the relative position of the tools has reached a predetermined reference position *during the relative motion of the tools toward one another*." Accordingly, Applicants respectfully submit that currently amended independent claim 40 (and the corresponding dependent claims) is allowable over both *Maier* and *Guenther*.

Applicants respectfully submit, therefore, that the instant application is in condition for prompt allowance. In the event that the Examiner finds impediment to prompt allowance of this application that may be clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney.

Dated this 18<sup>th</sup> day of April, 2008.

Respectfully submitted,

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